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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,022	02/26/2002	Jan Thomas Miksovsky	MSFT118568	4321

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EXAMINER

HIRL, JOSEPH P

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,022

Applicant(s)

MIKSOVSKY, JAN THOMAS

Examiner

Joseph P. Hirl

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 12-31 are pending in this application.

Specification

2. Page 17, line 8, remove "(Attorney Docket No. MSFT-1-18569)."

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms "other software" and "other facts" are indistinctive and render the claim indefinite

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 12 is rejected under 35 USC 112, first paragraph because current case law (and accordingly, the MPEP) require such a rejection if a 101 rejection is given because when Applicant has not in fact disclosed the practical application for the invention, as a matter of law there is no way Applicant could have disclosed how to practice the undisclosed practical application. This is how the MPEP puts it:

("The how to use prong of section 112 **incorporates as a matter of law** the requirement of 35U.S.C. 101 that the specification disclose as a matter of fact a practical utility for the invention.... If the application fails as a matter of fact to satisfy 35 U.S.C. 101, then the application

also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. § 112."); In re Kirk, '376 F.2d 936, 942, 153 USPQ 48, 53 (CCPA 1967) ("Necessarily, compliance with § 112 requires a description of how to use presently useful inventions, otherwise an applicant would anomalously be required to teach how to use a useless invention."). See, MPEP 21107.01 (IV), quoting In re Kirk (emphasis added).

Therefore, claim 12 is rejected on this basis.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 12-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Bertrand et al (U. S. Pub. 2002/0069189 referred to as **Bertrand**). Specific Examination considerations applicable to all claims are identified at the end of the office action.

Claim 12

Bertrand anticipates a) an application for generating, in response to user interface designer inputs, at least one intention, said at least one intention including an associated set of parameters (**Bertrand**, p 0324); and b) an expert system for receiving said at least one intention and said associated set of parameters, said expert system including a multitude of code modules, each of said code modules including a set of

rules, each of said rules including a template, in response to receiving said at least one intention and said associated set of parameters said expert system (**Bertrand**, p 0326; Examiner's Note (EN); OOPS is the code module establishing the rules from which feedback describes the business deliverable or template): i) selecting a code module for said multitude of code modules (**Bertrand**, p 0083); ii) selecting a rule from said set of rules included in said selected code module (**Bertrand**, p 0324); and iii) generating user interface instructions in accordance with the template associated with said selected rule (**Bertrand**, p 0326; EN; OOPS is the code module establishing the rules from which feedback describes the business deliverable or template).

Claim 13

Bertrand anticipates a) in response to user interface designer inputs, said application producing at least one intention, said at least one intention having an associated set of parameters (**Bertrand**, p 0324); b) supplying said at least one intention and its associated set of parameters to an expert system (**Bertrand**, p 0326); c) in response to receiving said at least one intention and its associated set of parameters, the expert system: i) selecting a code module from a multitude of code modules (**Bertrand**, p 0083); ii) selecting a rule from a set of rules within the selected code module (**Bertrand**, p 0324); and iii) generating user interface instructions from a template associated with the selected rule (**Bertrand**, p 0326; EN; OOPS is the code module establishing the rules from which feedback describes the business deliverable or template); d) supplying said user interface instructions to said application (**Bertrand**,

p 0326); and e) in response to receiving said user interface instructions, said application producing a user interface on said display (**Bertrand**, p 0081).

Claim 14

Bertrand anticipates an application including an incomplete user interface and being adapted to store multiple intentions of a user interface designer of the application, each intention including a set of parameters and at least one of posing a question to the user presenting a piece of information to the user, and defining a task for the user to perform, the incomplete user interface of the application being completed when the one or more intentions are realized (**Bertrand**, ps 0324; 0326; 0389; 0234); and an expert system including one or more components for realizing the multiple intentions, the expert system receiving one of the multiple intentions and each received intention identifying and activating a corresponding component for realizing the received intention, each corresponding component programmatically comprising a set of rules extracted from guidelines, conventions, and principles of user interface design, the set of parameters supplied with each received intention aiding the corresponding component to choose and execute a rule from the set of rules, each rule producing a user interface from a template different from other templates used by other rules (**Bertrand**, ps 0324; 0326).

Claim 15

Bertrand anticipates the produced user interface includes at least one of a graphical user interface, a command-line interface, and an audio user interface (**Bertrand**, p 0081).

Claim 16

Bertrand anticipates comprising a source of external factors, the source of external factors containing information related to the operating environment of the application as well as the background of the user so as to aid the corresponding component to choose and execute a rule from the set of rules (**Bertrand**, ps 0137; 0341; Fig. 8).

Claim 17

Bertrand anticipates each external factor includes at least one of the type of computer on which the application is running, the type of operating system on which the application is running, the types of available input devices, the types of available output devices, the background of the user, the existence of other software, and other facts external to the system (**Bertrand**, p 0109).

Claim 18

Bertrand anticipates each parameter from the set of parameters includes at least one of textual information, a set of choices from which the user is expected to make a selection, pieces of data which the user is allowed to manipulate, a default response to a question posed by the user, an indication that the user is required to respond to the question, an indication that the user may opt out from responding to the question, a type of data that is expected to be received in response to an interaction with the user, a set of constraints on the dimensions of the generated user interface, and an indication of the visual style which the generated user interface may take (**Bertrand**, ps 0326; Fig. 46).

Claims 19, 25

Bertrand anticipates receiving a user interface goal by the expert system, the user interface goal including at least one of a question to be posed to the user, a piece of information to be communicated to the user, and a task to be performed by the user (**Bertrand**, ps 0324; 0326; 0389; 0234); receiving a set of parameters by the expert system, each parameter including at least one of information for presenting to the user, information for the task to be performed by the user, and information for constraining the generated user interface (**Bertrand**, ps 0324; 0326); and generating a user interface by selecting a code module from a set of code modules, each code module being designed to generate user interfaces from multiple templates, the act of selecting a code module including selecting a rule from a set of rules extracted from guidelines, conventions, and principles of user interface design, the act of selecting a rule being aided by the set of parameters, the user interface being produced from a template when the selected rule is executed (**Bertrand**, ps 0083; 0324; 0326).

Claims 20, 26

Bertrand anticipates examining selectively a set of external factors by the expert system each factor being selected from the operating environment of the computer system and the background of the user, the act of selecting a rule being further aided by the set of external factors (**Bertrand**, ps 0137; 0341; Fig. 8).

Claims 21, 27

Bertrand anticipates a user interface goal includes at least one of making the user supply a single string of text, making the user supply a single number, making the

user pick a single item from a list, making the user pick several items from a list, making the user arrange the items in a list in a preferred order, making the user manage a list of items, making the user organize items in a given structure, and making the user apply one or more operations on a selection of items in a list (**Bertrand**, Fig. 8).

Claims 22, 28

Bertrand anticipates the method is executed at run time while other applications are running (**Bertrand**, p 0081; Fig. 8; workstations are multiprocessors).

Claims 23, 29

Bertrand anticipates the method is executed at design time so that user interfaces generated by the method are stored on storage media (**Bertrand**, ps 0081, 0324, 0326; 0338 Fig. 8; EN: capturing of real time events as the students go through the course requires storage of such events for analysis) .

Claims 24, 30

Bertrand anticipates the generated user interface includes a pagefunction (**Bertrand**, p 0129).

Claim 31

Bertrand anticipates a) in response to user interface designer inputs, said application producing at least one intention, said at least one intention having an associated set of parameters (**Bertrand**, ps 0324; 0326; 0389; 0234); b) supplying said at least one intention and its associated set of parameters to an expert system (**Bertrand**, ps 0324; 0326); c) in response to receiving said at least one intention and its associated set of parameters, the expert system: i) selecting a code module from a

multitude of code modules (**Bertrand**, p 0083); ii) selecting a rule from a set of rules within the selected code module (**Bertrand**, p 0324); and iii) generating user interface instructions from a template associated with the selected rule (**Bertrand**, p 0326; EN; OOPS is the code module establishing the rules from which feedback describes the business deliverable or template); d) supplying said user interface instructions to said application (**Bertrand**, p 0326); and e) in response to receiving said user interface instructions, said application producing a user interface on said display (**Bertrand**, p 0081).

Examination Considerations

11. The claims and only the claims form the metes and bounds of the invention.

“Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)” (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

12. Examiner’s Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further

indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

13. Examiner's Opinion

Para 9 above applies. Bertrand's prior art covers the range of code development in the form of object oriented analysis implemented in a system concept tailored to match the student on an interactive basis that specifically involves rules for engagement with the student.

Conclusion

14. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

- Handel et al, U.S. Pub 2002/0035501
- Bauer, U. S. Patent 5,877,759
- Hovitz et al, U. S. Patent 6,262,730

15. Claims 12-31 are rejected.

Correspondence Information

16. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is

(703) 305-1668. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (703) 308-3179.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,
Washington, D. C. 20231;

or faxed to:

(703) 746-7239 (for formal communications intended for entry);

or faxed to:

(703) 746-7290 (for informal or draft communications with notation of "Proposed" or "Draft" for the desk of the Examiner).

Hand-delivered responses should be brought to:

Receptionist, Crystal Park II
2121 Crystal Drive,
Arlington, Virginia.



Joseph P. Hirl

May 12, 2004